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EXAMINER				
SCHEIBEL, ROBERT C				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,768

Applicant(s)

MIYATA ET AL.

Examiner

ROBERT C. SCHEIBEL

Art Unit

2619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is directed towards an address translating program, *per se*. The claim indicates the intended use of the program and recites the steps of the program itself. This program is functional descriptive material which is held to be non-statutory when claimed *per se*. As such, claim 1 is drawn towards non-statutory subject matter. For further information, please see Annex 4 (pages 50-57) of "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility".

Claims 2-5 depend from claim 1 and thus have the same deficiency and are also rejected as being drawn to non-statutory subject matter.

Claim Objections

2. Claim 7 is objected to because of the following informalities:
 - Lines 4-5 contain the phrase "server, said address translating method comprising the steps of:". However, the claim is drawn towards an apparatus. Examiner

believes this to be a typographical error and requests that Applicant correct this language to be consistent with the rest of the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims **1-3 and 5-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 7,123,613 to Chawla et al in view of U.S. Patent Application Publication 2001/0030970 to Wiryaman et al and in further view of U.S. Patent Application Publication 2005/0021963 to Tomkow.

Regarding claims **1, 6, 7, and 8**, Chawla discloses a general system whereby a packet is transmitted from a client to a server via a proxy server (see figure 12, for example). Chawla also

discloses that the source address of the request is translated from the client (see elements 210 and 212 of figure 12) to the proxy server (see element 214 of figure 12). However, Chawla does not disclose the limitations of receiving the packet, analyzing the contents, translating the source address to be that of the client and transmitting the packet to the server, or receiving a response packet and translating the source address to be that of the proxy server and then transmitting that packet to the proxy server.

However, Wiryaman discloses these limitations in the teaching of back-end transparency on pages 6-7. Specifically, Wiryaman discloses:

translating said source address of said request packet into the acquired address of said client and transmitting said request packet to said server (see lines 6-8 in column 1 on page 7 which describes how the packet processor modifies the source address to be the client computer's address); and

receiving a response packet in response to said request packet from said server (lines 8-9 of column 1 on page 7 – “when the server computer replies with the data), translating a destination address of said response packet from the address of said client into the address of said proxy server (redirecting the packets to the HTTP proxy; see lines 8-15 on column 1 of page 7), and transmitting said response packet to said proxy server (redirecting the packets to the HTTP proxy; see lines 8-15 on column 1 of page 7).

Chawla and Wiryaman are analogous art because they are from client-server communications. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Chawla to add back-end transparency by using a device with the functionality of the packet processor 420 of Wiryaman. The motivation for doing so would

have been to allow a means by which the server is not aware that another device is diverting communications and performing proxy processing as suggested by Wiryaman in paragraph 71 on page 6.

However, Chawla and Wiryaman do not disclose expressly the limitation of analyzing contents of said request packet to acquire the address of said client. However, Tomkow discloses a client-server system whereby the IP address of the client is determined by analyzing the contents of the packet (specifically, the HTTP header - see element 1311 in figure 13 and the associated descriptions in paragraphs 359 and 367 on page 19).

Chawla and Tomkow are analogous art because they are from client-server communications. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to acquire the client address directly from the packet instead of from a table in the device. The motivation for doing so would have been to simplify the processing by removing the need for maintaining the tables in the outbound (client to server) direction. Therefore, it would have been obvious to combine Chawla, Wiryaman, and Tomkow for the benefit of simplifying the implementation to obtain the invention as specified in claims 1, 6, 7, and 8.

Regarding claim 2, Chawla discloses the limitation of performing the process of for changing said source address of said request packet, acquiring the address of said proxy server from a storage area in which the address of said proxy server is registered in advance (see step 98 of Figure 5; although this does not explicitly indicate the storage where the proxy server IP

address is acquired, it is clearly retrieved from memory by the router in order to perform this step).

Regarding claim 3, Chawla does not disclose expressly the limitations of the claim. However, Wiryaman discloses the limitations of:

when said source address of said request packet is translated, storing the address of said proxy server set as said source address to be translated and the address of said client set as said source address that is translated, in association with each other in a database (see paragraph 78 on page 7 which indicates that the packet processor uses a database (network table 456) to perform the source address translation; clearly, this information must be stored in the table initially in order to retrieve it for the purposes of translating back to the client address when the response packet is received.);

when said response packet is received, referring to said database to determine the address of said client to be set as said destination address (again, see paragraph 78 on page 7 which indicates that the packet processor uses a database (network table 456) to perform the source address translation).

Chawla and Wiryaman are analogous art because they are from client-server communications. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Chawla to add back-end transparency by using a device with the functionality of the packet processor 420 of Wiryaman. The motivation for doing so would have been to allow a means by which the server is not aware that another device is diverting communications and performing proxy processing as suggested by Wiryaman in paragraph 71 on

page 6. Therefore, it would have been obvious to combine Chawla, Wiryaman, and Tomkow for the benefit of simplifying the implementation to obtain the invention as specified in claim 3.

Regarding claim 5, Chawla and Wiryaman do not disclose expressly the limitation stated in the claim. However, Tomkow discloses the limitation that the address of said client is acquired from an application header in said request packet in see element 1311 in figure 13 and the associated descriptions in paragraphs 359 and 367 on page 19.

Chawla, Wiryaman and Tomkow are analogous art because they are from client-server communications. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to acquire the client address directly from the packet instead of from a table in the device. The motivation for doing so would have been to simplify the processing by removing the need for maintaining the tables in the outbound (client to server) direction. Therefore, it would have been obvious to combine Chawla, Wiryaman, and Tomkow for the benefit of simplifying the implementation to obtain the invention as specified in claim 5.

Allowable Subject Matter

6. Claim 4 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 101 set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. Patent Application Publication 2007/0214262 discloses a personal server technology with firewall detection and penetration.
- U.S. Patent Application Publication 2007/0115993 discloses a method for network deception and emulation.
- U.S. Patent Application Publication 2007/0005765 discloses a system for network access control using network address translation.
- U.S. Patent Application Publication 2005/0091341 discloses a method for detecting a reverse proxy and establishing a tunneled connection.
- U.S. Patent Application Publication 2002/0035639 discloses a method for a packet director.
- U.S. Patent 7,318,100 discloses a method for cooperative proxy auto-discovery and connection interception.
- U.S. Patent 7,149,222 discloses an integrated access point network device.
- U.S. Patent 7,136,359 discloses a method and apparatus for transparently proxying a connection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT C. SCHEIBEL whose telephone number is (571)272-3169. The examiner can normally be reached on Mon-Fri from 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing F. Chan can be reached on 571-272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Wing F Chan/
Supervisory Patent Examiner, Art Unit 2619
3/14/08

Robert C. Scheibel
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